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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,427	02/01/2006	Manfred Bick	DNAG-313	8861
24972	7590	12/08/2008		
FULBRIGHT & JAWORSKI, LLP				
666 FIFTH AVE				
NEW YORK, NY 10103-3198				
EXAMINER				
ZHU, WEIPING				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
12/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,427

Applicant(s)

BICK ET AL.

Examiner

WEIPING ZHU

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Claims

1. Claims 22-45 are currently under examination, wherein claim 22 has been amended and claims 44 and 45 have been newly added in applicant's amendment filed on October 24, 2008.

Status of Previous Rejections

2. The previous rejections of claims 22-43 under 35 U.S.C. 103 (a) as stated in the Office action dated April 25, 2008 have been maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shekhter et al. (US 6,558,447 B1).

Claims 22-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shekhter et al. ('447 B1) as stated in the Office action dated April 25, 2008.

With respect to the amended feature of the instant claim 22, Shekhter et al. ('447 B1) discloses mixing an oxide of Nb and Ta with a reducing agent and heating the mixture in an oven to 1000°C, optionally under an atmosphere of hydrogen until a reduction starts ((col. 5, line 46 to col. 7, line 27)).

With respect to the new claim 44, the teaching of Shekhter et al. ('447 B1) regarding the limitations in the instant claim 22 as discussed in the Office action dated April 25, 2008 is properly applied. Shekhter et al. ('447 B1) further discloses that the process can be applied to co-produce metal powders comprising Ti, Zr, Hf and V (col. 3, line 66 to col. 4, line 8 and col. 20, lines 16-26).

With respect to the new claim 45, the teaching of Shekhter et al. ('447 B1) regarding the limitations in the instant claim 22 as discussed in the Office action dated April 25, 2008 is properly applied. Shekhter et al. ('447 B1) further teaches mixing an oxide powder of Nb and/or Ta with finely divided powders of reducing metals or metal hydrides (col. 7, lines 3-12) without limiting the order of the mixing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sequentially mixing an oxide of at least one of Nb and Ta with a reducing agent as claimed with expected success, because Shekhter et al. ('447 B1) teaches the same utility for any orders of mixing. See MPEP 2144.05 I.

Response to Arguments

4. The applicant's arguments filed on October 24, 2008 have been fully considered but they are not persuasive.

The applicant argues that Shekhter et al. ('447 B1)'s process is a two-stage reduction process which also requires a deactivation of the reduced metal with oxygen. In response, the examiner notes that the rejection was based on the prior art's broad disclosure rather than preferred embodiments. See MPEP 2123. It is noted that Shekhter et al. ('447 B1) does disclose an one-stage reduction without the requirement

of the deactivation step (col. 20, lines 16-26). Furthermore, the transitional term "comprising" in the instant claims is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

WZ

11/25/2008

Application Number**Application/Control No.**

10/564,427

Examiner

WEIPING ZHU

**Applicant(s)/Patent under
Reexamination**

BICK ET AL.

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